

AMENDMENT AND RESPONSE UNDER 37 C.F.R. 1.116
Serial Number: 09/883,790
Filing Date: June 18, 2001
Title: COMPOSITE SOFTBALL BAT

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REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on May 1, 2003, and the references cited therewith. Reconsideration of this application, as amended, and in view of the following remarks is requested. By this amendment, claims 5, 6 and 8 are amended to the correct dependency, no claims are canceled, and claims 17-29 are added. Claims 9-16 remain withdrawn from consideration.

§112 Rejection of the Claims

A. Rejection: Claims 5-8 were rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

B. Response: Claims 5, 6 and 8 have been amended to depend from independent claim 1. Claims 5-8 now overcome the rejection under 35 USC § 112, second paragraph.

§102 Rejection of the Claims

A. Rejection: Claims 1, 2 and 6 were rejected under 35 USC § 102(b) as being anticipated by Uke (U.S. 5,303,917).

B. Response: Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Claim 1 recites "...a sleeve force fit within the hitting surface, wherein the hitting surface and the sleeve are comprised of composite materials; wherein the hitting surface is made from a first set of fibers and a first resin and wherein the sleeve is made from a second set of fibers and a second resin, the second set of fibers and the second resin being different than the first set of fibers and first resin." The Uke reference relied upon by the Examiner fails to disclose each element of claim 1. The Uke reference does not teach that a hitting surface made from a first set of fibers and a first resin and a sleeve made from a second set of fibers and a second resin. The first embodiment of Uke fails to teach a sleeve associated with the hitting surface. The second embodiment also fails to teach a

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sleeve within the hitting surface. Specifically, the sleeve 60 of Uke is outside of inner member 58. According to Uke, the "...second or outer tubular member 60 is a protective sleeve which engages telescopically over the inner member 58..."(See column 6, lines 35-38). As a result, the rejection of claim 1 is improper since Uke fails to teach all of the elements set forth in Claim 1. In addition, claims 2 and 6 depend from claim 1 and include its limitations. Therefore, claims 2 and 6 also overcome the Examiners rejection under 35 USC § 102(b) since Uke fails to teach all of the elements set forth in claims 2 and 6.

§103 Rejection of the Claims

A. Rejection: Claims 3, 5, 7 and 8 were rejected under 35 USC § 103(a) as being unpatentable over Uke.

B. Response: To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to an art worker, to modify the references or combine reference teachings so as to arrive at the claimed invention. Third, the art must provide a reasonable expectation of success. M.P.E.P. § 2143. The teaching or suggestion to arrive at the claimed invention and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure (M.P.E.P. § 2143, citing with favor *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Uke fails to teach or suggest all the elements of claims 3, 5, 7 and 8. Each of these claims depends from claim 1, either directly or indirectly. As discussed above, Uke does not teach or suggest a sleeve positioned within the hitting surface of the bat as recited in claim 1. Claims 3, 5, 7 and 8 all include this recitation by their dependency on claim 1. In addition, there is no suggestion or motivation, either in the cited reference or in the knowledge generally available, to modify the reference to arrive at the claimed invention. In fact, if the sleeve were to be modified to move the sleeve from its position outside the bat to a position inside the hitting surface would destroy a stated purpose of the Uke sleeve—namely to provide a protective

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coating. Therefore, the Examiner has failed to make a prima facie case of obviousness using the Uke reference with respect to claims 3, 5, 7 and 8 and therefore the rejection is overcome.

In addition, The Examiner rejected claims 3, 5, 7 and 8 based solely on Uke reference. Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in the Uke reference. Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 612-373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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The undersigned hereby certifies that this correspondence is being transmitted by facsimile (FAX NO. 703-872-9303)
to: Attn.: Examiner Mark S. Graham, GAU 3711, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,
on this 1st day of October 2003.

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